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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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| 08/474,715 | 06/07/95 | FUJITA | M 038612 |

11M1/1121
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EXAMINER

ART UNIT PAPER NUMBER

1113

DATE MAILED: 11/21/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☐ This application has been examined ☒ Responsive to communication filed on 8/14/96
9/12/96 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1 and 4-9 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 2, 3 and 10 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1 and 4-9 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

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15. Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The language "core grains" is indefinite and lacks antecedent basis. No "core grains" are previously described in claim 4 or independent claim 1. It is not clear if the term "core grains" is the same as the core of the grains.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans et al. further in view of Tanemura et al. or Shuto et al. '719 for the same reasons as set forth in paragraph 20 of the Office action dated 03/14/96.

17. Applicants' arguments filed 09/12/96 and 08/14/96 have been fully considered but they are not deemed to be persuasive.

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The rejections based on Evans et al. alone are withdrawn in view of applicants' amendments requiring the subject matter of claim 3 into claim 1.

Applicants argue that the comparative data of the specification establishes unexpected results when using the compounds of general Formula (A), (B) or (C) with the core/shell tabular grains as in claim 1. The comparative data of the specification has been carefully considered but is not of sufficient scope, weight and character to obviate the prima facie case of obviousness. It is not clear how Table 4 of the specification is evidence of unexpected superiority when using the sulfur compounds with certain types of tabular grains. Comparing Sample 201 with 204, 202 with 205, and 203 with 206 shows the effects of adding the sulfur compounds of the instant claims to silver halide tabular grains. Sample 201 versus 204 shows the effects of using the sulfur compounds with comparative types of grains. 202 with 205 and 203 with 206 shows the effects of using the sulfur compounds with the inventive types of grains. Maximum density, minimum density and metal sensitivity are all similar or increase by similar amounts when comparing the differences between 201 and 204 with the differences between 202 and 205 or 203 and 206. When comparing the negative sensitivities, it appears that there is a slightly greater drop in negative sensitivities when comparing the differences in 201

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versus 204 with 202 versus 205 or 203 with 206. It is the examiners position that these small quantitative differences are not an unexpected result.

Thus from the comparative data of Table 4 it appears that adding the sulfur compounds has the same or very similar result when added to comparative types of grains or when added to the inventive types of grains.

18. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lee C. Wright, whose telephone number is (703) 308-2293. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter, can be reached on (703) 308-2303.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter, can be reached on (703) 308-2303.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.

The fax telephone number for Art Unit 1113 is (703) 305-3599.

Lee C. Wright
Primary Examiner
Art Unit 1113

LCW:cdc
November 20, 1996